

#8 / 1208  
12/17/00 PATENT  
Attorney Docket No. 3495.0111-11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE RECEIVED

In re Application of: )

DEC 07 2000

Bernard DUJON et al. )

Serial Number: 09/492,697 )

Group Art Unit: 1633 TECH CENTER 1600/2400

Filed: January 27, 2000 )

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING THE  
ENZYME I-SCEI AND THE USES THEREOF



Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

**SUBMISSION OF TERMINAL DISCLAIMERS**

Applicants submit two (2) Terminal Disclaimers in the above-referenced application, a copy of which has been executed by each of the assignees (INSTITUT PASTEUR and UNIVERSITY PARIS VI, also known as UNIVERSITE PIERRE ET MARIE CURIE) and enclosed herewith. Please associate these papers with the above-identified application. The requisite fee of \$220.00 is enclosed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER L.L.P.

12/05/2000 RHARIS1 00000108 09492697

02 FC:148

110.00 DP

By: 

Salvatore J. Arrigo

Reg. No. 46,063

Tel: (202) 408-4000

Fax: (202) 408-4400

Email: arrigos@finnegan.com

Dated: December 5, 2000

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

PATENT

Atty. Docket No. 3495.0111-11

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )

Bernard DUJON et al. )

Serial Number: 09/492,697 )

Filed: January 27, 2000 )

Group Art Unit: 1651

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I  
AND THE USES THEREOF

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

TERMINAL DISCLAIMER

Petitioner ("assignees") INSTITUT PASTEUR, duly organized under the laws France, and having its principal place of business at 28 rue du Docteur Roux, 75724 Paris Cedex 15, France and UNIVERSITE PARIS VI, also known as UNIVERSITE PIERRE ET MARIE CURIE, duly organized under the laws France, and having its principal place of business at 4, place Jussieu, 75252 Paris, France, herein after referred to as "the Assignees", represent that they are the only assignees of the entire right, title and interest in and to both the above-identified application, Serial No. 09/492,697 filed January 27, 2000, for NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF in the name of Bernard DUJON et al. as indicated by assignment duly recorded at Reel 7450, Frame 0446, and Reel 7450, Frame 0500, in the United States Patent and Trademark Office (copies attached) and application Serial No. 09/119,024

1

## LAW OFFICES

EGAN, HENDERSON,  
LABOW, CARRETT,  
DUNNER, L.L.P.  
301 I STREET, N.W.  
WASHINGTON, DC 20005  
202-408-4000

12/05/2000 RHARIS1 00000108 09492697

03 FC:148

110.00 0P

Ser. No: 09/492,697

filed July 20, 1998, now U.S. Patent No. 5,948,678, for NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF in the name of Bernard DUJON et al. as indicated by assignment(s) duly recorded at Reel 7450, Frame 0446, and Reel 7450, Frame 0500, in the United States Patent and Trademark Office (copies attached). The Assignees further represent that to the best of Assignees' knowledge and belief, title to the above-identified application, Serial No. 09/492,697, and the United States Patent No. 5,948,678 are in assignee, which is submitting this Terminal Disclaimer.

To obviate a double patenting rejection, the Assignees hereby disclaim, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on the above-identified application, Serial No. 09/492,697, which would extend beyond the expiration date of Patent No. 5,948,678, and hereby agree that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. 5,948,678, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim the terminal part of any patent granted on Appl. Serial No. 09/492,697, that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of Patent No. 5,948,678, as presently shortened by any terminal disclaimer, in the event that Patent No. 5,948,678: expires for failure to pay a maintenance fee, is held unenforceable, is

Ser. No: 09/492,697


found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

The undersigned is authorized to act on behalf of the assignee INSTITUT PASTEUR.

I hereby declare that all statements made of my own knowledge and belief are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

INSTITUT PASTEUR

  
INSTITUT PASTEUR

25-28, rue du Docteur Roux  
75724 Paris Cedex 15

Dated: 24 / 11 / 00

  
By: Anne BELLOD  
Title: Directeur de la Communication  
et des Partenariats Industriels

## CERTIFICATE UNDER 37 CFR 3.73(b)

Applicant: Bernard DUJON et al.Application No.: 09/492,697 Filed: January 27, 2000For: NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-Sce AND THE  
USES THEREOFINSTITUT PASTEUR  
(Name of Assignee)a PRIVATE INSTITUTE  
(Type of Assignee, e.g., corporation,  
partnership, university, government  
agency, etc.)

certifies that it is an assignee of an undivided part interest in the patent application identified above by virtue of either:

A.☒ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel 07450, Frame 0446, and at Reel 07450, Frame 0500.

OR

B.☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

08/466,698

[X] Copies of assignments of other documents in the chain of title are attached.

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

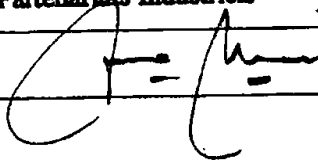
I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 24/11/00

Name: **Anne BELLOD**  
Directrice adjointe de la Valorisation  
et des Partenariats Industriels

Title:

Signature:

  
**INSTITUT PASTEUR**

25-28, rue du Docteur Roux  
75724 Paris Cedex 15

JUN 12 1995



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MAY 31, 1995

PTAS  
FINNEGAN, HENDERSON, FARABOW ET AL  
JANE E.R. POTTER  
1300 I STREET, N.W.  
WASHINGTON, D.C. 20005



\*100000313A\*

03495 0111-0

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

RECORDATION DATE: 02/22/1995

REEL/FRAME: 7450/0446  
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
DUJON, BERNARD

DOC DATE: 02/03/1995

ASSIGNEE:  
UNIVERSITE PIERRE ET MARIE CURIE  
4, PLACE JUSSIEU  
PARIS, FRANCE 75252

SERIAL NUMBER: 08336241  
PATENT NUMBER:

FILING DATE: 11/07/1994  
ISSUE DATE:

MARGARET LASALLE, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

DK4D  
15-12-0  
C40

FORM PTO-158  
Rev. 6-93)



05-09-1995



100000313

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Attv. Docket No. 3495.0111-03

To the Honorable Commissioner

Please record the enclosed original documents or copy thereof.

ATTN. BOX ASSIGNEE

1. Name of conveying party(ies):

Bernard DUJON

Additional names(s) of conveying party(ies)  
attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other

Execution Date: February 3, 1995

2. Name and address of receiving party(ies)

Name: Universite Pierre et Marie Curie

Internal Address: \_\_\_\_\_

Street Address: \_\_\_\_\_

4, place Jussieu

City: 75252 Paris, France

State: \_\_\_\_\_ ZIP: \_\_\_\_\_

Additional name(s) & address(es) attached  
☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application,  
the execution date of the application is: \_\_\_\_\_

A. Patent Application No. (s)

08/336,241

B. Patent No. (s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom  
correspondence concerning document  
should be mailed:

Name: Jane E. R. Potter

Internal Address: \_\_\_\_\_

Finnegan, Henderson, Farabow, Garrett  
& Dunner

Street Address: \_\_\_\_\_

1300 I Street, N.W.

City: Washington, D.C.

State: \_\_\_\_\_ ZIP: 20005

6. Total number of applications and patents  
involved 1

7. Total fee (37 CFR 3.41): \$ 40.00

☒ Enclosed

☐ Authorized to be charged to  
deposit account

8. Deposit account number: \_\_\_\_\_

Attach duplicate copy of this page if  
paying by deposit account.

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct  
and any attached copy is a true copy of the original document.

Jane E. R. Potter

Name of Person Signing

140 KJ 03/01/95 06336241

Jane E. R. Potter  
Signature

February 22, 1995

Date

1 561

40.00 CK

Total number of pages including cover sheet, attachments and document: 2



## ASSIGNMENT

WHEREAS I/We, the below named inventor(s), [hereinafter referred to as Assignor(s)], have made an invention entitled:  
NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF  
(Title of Invention)

for which I/We executed an application for United States Letters Patent concurrently herewith or filed an application for  
United States Letters Patent on November 7, 19 94 (Serial No. 08/336,241); and

WHEREAS, Universite Pierre et Marie Curie  
(Full Name of Assignee)

a corporation of France

(Country of Incorporation)

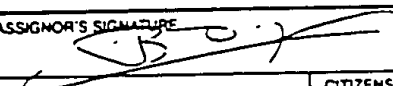
whose post office address is 4, place Jussieu, 75252 Paris Cedex 05, France

(hereinafter referred to as Assignee), is desirous of securing the entire right, title, and interest in and to this invention, the application for United States Letters Patent on this invention and the Letters Patent to be issued upon this application;

NOW THEREFORE, be it known that, for good and valuable consideration the receipt of which from assignee is hereby acknowledged, I/We, as assignor(s), have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over unto the assignee, its lawful successors and assigns, my/our entire right, title, and interest in and to this invention and this application, and all divisions, and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues thereof; and I/We hereby authorize and request the Commissioner of Patents and Trademarks of the United States to issue all Letters Patent for this invention to assignee, its successors and assigns, in accordance with the terms of this Assignment;

AND, I/WE HEREBY further covenant and agree that I/We will, without further consideration, communicate with assignee, its successors and assigns, any facts known to me/us respecting this invention and testify in any legal proceeding, sign all lawful papers when called upon to do so, execute and deliver all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors and assigns, execute all divisional, continuation, and reissue applications, make all rightful oaths and generally do everything possible to aid assignee, its successors and assigns, to obtain and enforce proper patent protection for this invention in the United States, it being understood that any expense incident to the execution of such papers shall be borne by the assignee, its successors and assigns.

IN TESTIMONY WHEREOF, I/We have hereunto set our hand(s).

1 FULL NAME OF SOLE OR FIRST ASSIGNOR <u>Bernard DUJON</u>	ASSIGNOR'S SIGNATURE 	DATE <u>3 FEB 95</u>
ADDRESS <u>6 rue de la Gruerie, 91190 Gif Sur Yvette, FR</u>	CITIZENSHIP <u>France</u>	
2 FULL NAME OF SECOND ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
3 FULL NAME OF THIRD ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
4 FULL NAME OF FOURTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
5 FULL NAME OF FIFTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
6 FULL NAME OF SIXTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	



LJM - EFC - JEP  
63495-0111-03  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MAY 31, 1995

PTAS  
FINNEGAN, HENDERSON, FARABOW, GARRETT  
& DUNNER - JANE E. R. POTTER  
1300 I STREET, N.W.  
WASHINGTON, D.C. 20005



\*100000314A\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/22/1995

REEL/FRAME: 7450/0500  
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

CHOULIKA, ANDRE

DOC DATE: 02/07/1995

ASSIGNOR:

PERRIN, ARNAUD

DOC DATE: 02/07/1995

ASSIGNOR:

NICHOLAS, JEAN-FRANCOIS

DOC DATE: 02/07/1995

ASSIGNEE:

INSTITUT PASTEUR  
28, RUE DU DOCTEUR ROUX  
PARIS, FRANCE 75724

SERIAL NUMBER: 08336241

FILING DATE: 11/07/1994

PATENT NUMBER:

ISSUE DATE:

JUN 9 1995

F. D. ...  
...

DK1

7450/0500 PAGE 2

MARGARET LASALLE, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

FORM PTO-1595  
Rev. 6-93)

RECO

05-09-199



100000314

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Atty. Docket No. 3495.0111-03

To the Honorable Commissioner of Patents and Trademarks:  
Please receive the attached original documents or copy thereof.

ATTN. BOX ASSIGNMENT

1. Name of conveying party(ies):

Andre CHOU  
Arnaud PERRIN

Jean-Francois NICOLAS

Additional names(s) of conveying party(ies)  
attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other

Execution Date: February 7, 1995

2. Name and address of receiving party(ies):

Name: Institut Pasteur

Internal Address:

Street Address:

28, rue du Docteur Roux

City: 75724 Paris, France

State: ZIP:

Additional name(s) & address(es) attached  
☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application,  
the execution date of the application is:

A. Patent Application No.(s)

08/336,241

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom  
correspondence concerning document  
should be mailed:

Name: Jane E. R. Potter

Internal Address:

Pinnegan, Henderson, Farabow, Garrett  
& Durner

Street Address:

1300 I Street, N.W.

City: Washington, D.C.

State: ZIP: 20005

6. Total number of applications and patents  
involved 1

7. Total fee (37 CFR 3.41): \$ 40.00

☒ Enclosed

☐ Authorized to be charged to  
deposit account

8. Deposit account number:

Attach duplicate copy of this page if  
paying by deposit account.

9. Statement and signature:

To the best of my knowledge and belief, the foregoing information is true and correct  
and any attached copy is a true copy of the original document.

Jane E. R. Potter

Name of Person Signing

Signature

February 22, 1995  
Date

Total number of pages including cover sheet, attachments and document:

SOLE/JOINT INVENTION  
(U.S. Rights Only)

# ASSIGNMENT

WHEREAS I/We, the below named inventor(s), [hereinafter referred to as Assignor(s)], have made an invention entitled:  
NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF  
(Title of Invention)

for which I/We executed an application for United States Letters Patent concurrently herewith or filed an application for  
United States Letters Patent on November 7, 19 94 (Serial No. 08/336,241); and

WHEREAS, Institut Pasteur  
(Full Name of Assignee)

a corporation of France  
(Country of Incorporation)

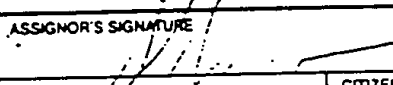
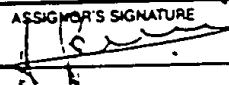
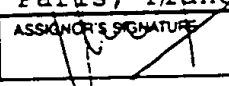
whose post office address is 28, rue du Docteur Roux, 75724 Paris Cedex 15, FRANCE

(hereinafter referred to as Assignee), is desirous of securing the entire right, title, and interest in and to this invention, the application for United States Letters Patent on this invention and the Letters Patent to be issued upon this application;

NOW THEREFORE, be it known that, for good and valuable consideration the receipt of which from assignee is hereby acknowledged, I/We, as assignor(s), have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over unto the assignee, its lawful successors and assigns, my/our entire right, title, and interest in and to this invention and this application, and all divisions, and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues thereof; and I/We hereby authorize and request the Commissioner of Patents and Trademarks of the United States to issue all Letters Patent for this invention to assignee, its successors and assigns, in accordance with the terms of this Assignment;

AND, I/WE HEREBY further covenant and agree that I/We will, without further consideration, communicate with assignee, its successors and assigns, any facts known to me/us respecting this invention and testify in any legal proceeding, sign all lawful papers when called upon to do so, execute and deliver all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors and assigns, execute all divisional, continuation, and reissue applications, make all rightful oaths and generally do everything possible to aid assignee, its successors and assigns, to obtain and enforce proper patent protection for this invention in the United States, it being understood that any expense incident to the execution of such papers shall be borne by the assignee, its successors and assigns.

IN TESTIMONY WHEREOF, I/We have hereunto set our hand(s).

1 FULL NAME OF SOLE OR FIRST ASSIGNOR <u>Andre CHOULIKA</u>	ASSIGNOR'S SIGNATURE 	DATE <u>07 FEB 95</u>
ADDRESS <u>3, rue F. Mouthon, 75015 Paris, France</u>	CITIZENSHIP <u>Lebanese</u>	
2 FULL NAME OF SECOND ASSIGNOR, IF ANY <u>Arnaud PERRIN</u>	ASSIGNOR'S SIGNATURE 	DATE <u>7 FEB 95</u>
ADDRESS <u>10, avenue P. Appell, 75014 Paris, France</u>	CITIZENSHIP <u>French</u>	
3 FULL NAME OF THIRD ASSIGNOR, IF ANY <u>Jean-Francois NICOLAS</u>	ASSIGNOR'S SIGNATURE 	DATE <u>7 Feb, 95</u>
ADDRESS <u>39, chemin de la Source - 78590 NOISY LE ROI, France</u>	CITIZENSHIP <u>French</u>	
4 FULL NAME OF FOURTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
5 FULL NAME OF FIFTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
6 FULL NAME OF SIXTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of: )

Bernard DUJON et al. )

Serial Number: 09/492,697 )

Filed: January 27, 2000 )

Group Art Unit: 1651

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I  
AND THE USES THEREOF

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

TERMINAL DISCLAIMER

Petitioner ("assignees") INSTITUT PASTEUR, duly organized under the laws France, and having its principal place of business at 28 rue du Docteur Roux, 75724 Paris Cedex 15, France and UNIVERSITE PARIS VI, also known as UNIVERSITE PIERRE ET MARIE CURIE, duly organized under the laws France, and having its principal place of business at 4, place Jussieu, 75252 Paris, France, herein after referred to as "the Assignees", represent that they are the only assignees of the entire right, title and interest in and to both the above-identified application, Serial No. 09/492,697 filed January 27, 2000, for NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF in the name of Bernard DUJON et al. as indicated by assignment duly recorded at Reel 7450, Frame 0446, and Reel 7450, Frame 0500, in the United States

Patent and Trademark Office (copies attached) and application Serial No. 09/119,024 filed July 20, 1998, now U.S. Patent No. 5,948,678, for NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF in the name of Bernard DUJON et al. as indicated by assignment(s) duly recorded at Reel 7450, Frame 0446, and Reel 7450, Frame 0500, in the United States Patent and Trademark Office (copies attached). The Assignees further represent that to the best of Assignees' knowledge and belief, title to the above-identified application, Serial No. 09/492,697, and the United States Patent No. 5,948,678 are in assignee, which is submitting this Terminal Disclaimer.

To obviate a double patenting rejection, the Assignees hereby disclaim, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on the above-identified application, Serial No. 09/492,697, which would extend beyond the expiration date of Patent No. 5,948,678, and hereby agree that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. 5,948,678, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim the terminal part of any patent granted on Appl. Serial No. 09/492,697, that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of Patent No. 5,948,678, as presently shortened by any terminal disclaimer, in the event that Patent No. 5,948,678: expires for failure to pay a maintenance fee, is held unenforceable, is

found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

The undersigned is authorized to act on behalf of the assignee UNIVERSITE PARIS VI/UNIVERSITE PIERRE ET MARIE CURIE.

I hereby declare that all statements made of my own knowledge and belief are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

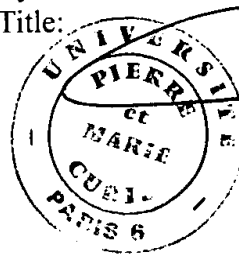
Respectfully submitted,

UNIVERSITE PARIS VI/  
UNIVERSITE PIERRE ET MARIE CURIE

Dated: 17/11/2000

Le Président  
de l'Université P. et M. Curie  
(Paris 6)

By:  
Title:



Jean DEMERLE



**CERTIFICATE UNDER 37 CFR 3.73(b)**

Applicant: Bernard DUJON et al.

Application No.: 09/492,697 Filed: January 27, 2000

For: NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-Sce AND THE  
USES THEREOF

UNIVERSITY PARIS VI (also known as Universite Pierre et Marie Curie), a  
UNIVERSITY, certifies that it is an assignee of an undivided part interest in the patent application identified above by virtue of either:

A.☒ An assignment from the inventor(s) of the patent application identified above.  
The assignment was recorded in the Patent and Trademark Office at Reel  
07450, Frame 0446, and at Reel 07450, Frame 0500.

OR

B.☐ A chain of title from the inventor(s), of the patent application identified above, to  
the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel  
\_\_\_\_, Frame \_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel  
\_\_\_\_, Frame \_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at Reel  
\_\_\_\_, Frame \_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental  
sheet.

☒ Copies of assignments of other documents in the chain of title are attached.

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

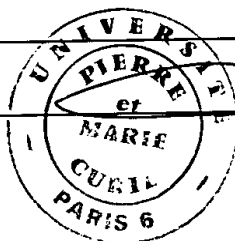
I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 17/11/2010

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Signature: \_\_\_\_\_



Le Président  
de l'Université P. et M. Curie  
(Paris 6)

Jean LEMERLE

JUN 12 1995



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MAY 31, 1995

PTAS  
FINNEGAN, HENDERSON, FARABOW ET AL  
JANE E.R. POTTER  
1300 I STREET, N.W.  
WASHINGTON, D.C. 20005



\*100000313A\*

03495 0111-02

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

RECORDATION DATE: 02/22/1995

REEL/FRAME: 7450/0446  
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
DUJON, BERNARD

DOC DATE: 02/03/1995

ASSIGNEE:  
UNIVERSITE PIERRE ET MARIE CURIE  
4, PLACE JUSSIEU  
PARIS, FRANCE 75252

SERIAL NUMBER: 08336241  
PATENT NUMBER:

FILING DATE: 11/07/1994  
ISSUE DATE:

MARGARET LASALLE, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

DK95  
15-12-95  
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05-09-1995



71-581

A

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Attv. Docket No. 3495.0111-03

To the Honorable Commissioner

100000313

Please record the attached original documents or copy thereof.

ATTN. BOX ASSIGNEE

1. Name of conveying party(ies):

Bernard DUJON

Additional names(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other

Execution Date: February 3, 1995

2. Name and address of receiving party(ies)

Name: Universite Pierre et Marie Curie

Internal Address:

Street Address:

4, place Jussieu

City: 75252 Paris, France

State: ZIP:

Additional name(s) & address(es) attached ☐ Yes ☒ No

4. Application number(s) or patent number(s):

☐ If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No. (s)

08/336,241

B. Patent No. (s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Jane E. R. Potter

Internal Address:

Finnegan, Henderson, Farabow, Garrett & Durner

Street Address:

1300 I Street, N.W.

City: Washington, D.C.

State: ZIP: 20005

6. Total number of applications and patents involved 1

7. Total fee (37 CFR 3.41): \$ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:   
Attach duplicate copy of this page if paying by deposit account.

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Jane E. R. Potter

Name of Person Signing

Jane E. R. Potter  
Signature

February 22, 1995

Date

140 KJ 03/01/95 06336241

1 581

40.00 CK

Total number of pages including cover sheet, attachments and document: 2

**ASSIGNMENT**

WHEREAS I/We, the below named inventor(s), [hereinafter referred to as Assignor(s)], have made an invention entitled:  
NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF  
(Title of Invention)

for which I/We executed an application for United States Letters Patent concurrently herewith or filed an application for United States Letters Patent on November 7, 19 94 (Serial No. 08/336,241); and

WHEREAS, Universite Pierre et Marie Curie

(Full Name of Assignee)

a corporation of France

(Country of Incorporation)

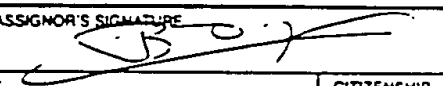
whose post office address is 4, place Jussieu, 75252 Paris Cedex 05, France

(hereinafter referred to as Assignee), is desirous of securing the entire right, title, and interest in and to this invention, the application for United States Letters Patent on this invention and the Letters Patent to be issued upon this application;

NOW THEREFORE, be it known that, for good and valuable consideration the receipt of which from assignee is hereby acknowledged, I/We, as assignor(s), have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over unto the assignee, its lawful successors and assigns, my/our entire right, title, and interest in and to this invention and this application, and all divisions, and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues thereof; and I/We hereby authorize and request the Commissioner of Patents and Trademarks of the United States to issue all Letters Patent for this invention to assignee, its successors and assigns, in accordance with the terms of this Assignment;

AND, I/WE HEREBY further covenant and agree that I/We will, without further consideration, communicate with assignee, its successors and assigns, any facts known to me/us respecting this invention and testify in any legal proceeding, sign all lawful papers when called upon to do so, execute and deliver all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors and assigns, execute all divisional, continuation, and reissue applications, make all rightful oaths and generally do everything possible to aid assignee, its successors and assigns, to obtain and enforce proper patent protection for this invention in the United States, it being understood that any expense incident to the execution of such papers shall be borne by the assignee, its successors and assigns.

IN TESTIMONY WHEREOF, I/We have hereunto set our hand(s).

1 FULL NAME OF SOLE OR FIRST ASSIGNOR <u>Bernard DUJON</u>	ASSIGNOR'S SIGNATURE 	DATE <u>3 FEB 95</u>
ADDRESS <u>6 rue de la Gruerie, 91190 Gif Sur Yvette, FR</u>	CITIZENSHIP <u>France</u>	
2 FULL NAME OF SECOND ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
3 FULL NAME OF THIRD ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
4 FULL NAME OF FOURTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
5 FULL NAME OF FIFTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	
6 FULL NAME OF SIXTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS	CITIZENSHIP	



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63495 - 0111 - 03

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MAY 31, 1995

PTAS  
FINNEGAN, HENDERSON, FARABOW, GARRETT  
& DUNNER - JANE E. R. POTTER  
1300 I STREET, N.W.  
WASHINGTON, D.C. 20005



UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/22/1995

REEL/FRAME: 7450/0500  
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

CHOULIKA, ANDRE

DOC DATE: 02/07/1995

ASSIGNOR:

PERRIN, ARNAUD

DOC DATE: 02/07/1995

ASSIGNOR:

NICHOLAS, JEAN-FRANCOIS

DOC DATE: 02/07/1995

ASSIGNEE:

INSTITUT PASTEUR  
28, RUE DU DOCTEUR ROUX  
PARIS, FRANCE 75724

SERIAL NUMBER: 08336241  
PATENT NUMBER:

FILING DATE: 11/07/1994  
ISSUE DATE:

JUN 9 1995

RECEIVED  
JUN 9 1995

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7450/0500 PAGE 2

MARGARET LASALLE, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

05-09-199



U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Of

Atty. Docket No. 3495.0111-03

To the Honorable Commissioner of Patents and Trademarks:

Please record the attached original documents or copy thereof.

ATTN. BOX ASSIGNEE

1. Name of conveying party(ies):

Andre CHO

Arnaud PERRIN

Jean-Francois NICOLAS

Additional names(s) of conveying party(ies)  
attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment

☐ Merger

☐ Security Agreement

☐ Change of Name

☐ Other

Execution Date: February 7, 1995

2. Name and address of receiving party(ies)

Name: Institut Pasteur

Internal Address:

Street Address:

28, rue du Docteur Roux

City: 75724 Paris, France

State: ZIP:

Additional name(s) & address(es) attached  
☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application,  
the execution date of the application is:

A. Patent Application No. (s)

08/336,241

B. Patent No. (s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom  
correspondence concerning document  
should be mailed:

Name: Jane E. R. Potter

Internal Address:

Finnegan, Henderson, Farabow, Garrett

Street Address:

1300 I Street, N.W.

City: Washington, D.C.

State: ZIP: 20005

6. Total number of applications and patents  
involved 1

7. Total fee (37 CFR 3.41): \$ 40.00

☒ Enclosed

☐ Authorized to be charged to  
deposit account

8. Deposit account number:

Attach duplicate copy of this page if  
paying by deposit account.

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct  
and any attached copy is a true copy of the original document.

Jane E. R. Potter

Name of Person Signing

*Jane E. R. Potter*  
Signature

February 22, 1995  
Date

Total number of pages including cover sheet, attachments and document:



# ASSIGNMENT

WHEREAS I/We, the below named inventor(s), [hereinafter referred to as Assignor(s)], have made an invention entitled:  
**NUCLEOTIDE SEQUENCE ENCODING THE ENZYME I-SCE I AND THE USES THEREOF**  
(Title of Invention)

for which I/We executed an application for United States Letters Patent concurrently herewith or filed an application for United States Letters Patent on November 7, 19 94 (Serial No. 08/336,241); and

WHEREAS, Institut Pasteur  
(Full Name of Assignee)

a corporation of France  
(Country of Incorporation)

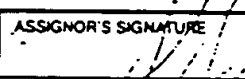
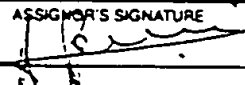
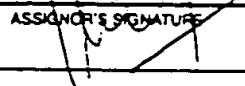
whose post office address is 28, rue du Docteur Roux, 75724 Paris Cedex 15, FRANCE

(hereinafter referred to as Assignee), is desirous of securing the entire right, title, and interest in and to this invention, the application for United States Letters Patent on this invention and the Letters Patent to be issued upon this application;

NOW THEREFORE, be it known that, for good and valuable consideration the receipt of which from assignee is hereby acknowledged, I/We, as assignor(s), have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over unto the assignee, its lawful successors and assigns, my/our entire right, title, and interest in and to this invention and this application, and all divisions, and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues thereof; and I/We hereby authorize and request the Commissioner of Patents and Trademarks of the United States to issue all Letters Patent for this invention to assignee, its successors and assigns, in accordance with the terms of this Assignment;

AND, I/WE HEREBY further covenant and agree that I/We will, without further consideration, communicate with assignee, its successors and assigns, any facts known to me/us respecting this invention and testify in any legal proceeding, sign all lawful papers when called upon to do so, execute and deliver all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors and assigns, execute all divisional, continuation, and reissue applications, make all rightful oaths and generally do everything possible to aid assignee, its successors and assigns, to obtain and enforce proper patent protection for this invention in the United States, it being understood that any expense incident to the execution of such papers shall be borne by the assignee, its successors and assigns.

IN TESTIMONY WHEREOF, I/We have hereunto set our hand(s).

1 FULL NAME OF SOLE OR FIRST ASSIGNOR <u>Andre CHOULIKA</u>	ASSIGNOR'S SIGNATURE 	DATE <u>02 FEB 95</u>
ADDRESS <u>3, rue F. Mouthon, 75015 Paris, France</u>		CITIZENSHIP <u>Lebanese</u>
2 FULL NAME OF SECOND ASSIGNOR, IF ANY <u>Arnaud PERRIN</u>	ASSIGNOR'S SIGNATURE 	DATE <u>7 FEB 95</u>
ADDRESS <u>10, avenue P. Appell, 75014 Paris, France</u>		CITIZENSHIP <u>French</u>
3 FULL NAME OF THIRD ASSIGNOR, IF ANY <u>Jean-Francois NICOLAS</u>	ASSIGNOR'S SIGNATURE 	DATE <u>7 Feb 95</u>
ADDRESS <u>39, chemin de la Source - 78590 NOISY LE ROI, France</u>		CITIZENSHIP <u>French</u>
4 FULL NAME OF FOURTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS		CITIZENSHIP
5 FULL NAME OF FIFTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS		CITIZENSHIP
6 FULL NAME OF SIXTH ASSIGNOR, IF ANY	ASSIGNOR'S SIGNATURE	DATE
ADDRESS		CITIZENSHIP